

## REMARKS

This amendment is responsive to the Ex Parte Quayle Action dated April 5, 2005.

Claims 1-36 were pending in this application.

All claims are indicated as being allowable.

### RENUMBERING OF CLAIMS 14-35 as 14-36.

The previously presented claims were number as 1-35. However, there were 2 instances of a claim 14, resulting in a total of 36 claims. Claims 14-35 have been renumbered as 14-36 with respective claim dependencies also renumbered.

Claims 1-36 remain pending in the application.

### FORMAL AMENDMENTS TO CLAIMS 29 and 30.

The Applicant has also amended claims 29 (previously claim 28) and 30 (previously claim 29) to formally correct grammatical, antecedent and spelling errors presented in the original claims.

No new issues are raised by these amendments. Explanations of the specific amendments are outlined below.

**ALL AMENDMENTS TO THE CLAIMS AS ENTERED HEREINABOVE HAVE BEEN MADE RELATIVE TO THE ORIGINAL PATENT TEXT.**

Explanation of amendment to claim 29.

The amendments to claim 29 relative to the prior text are specifically identified below as a courtesy to the examiner:

a ~~supporting~~ yoke element coupled to said forward portion of said receiver, said ~~support~~ yoke element extending forwardly from said receiver into said ~~reward~~ rearward end of said handguard piece, said yoke element being configured and arranged for engagement with said rearward end of said handguard piece,

wherein said ~~supporting~~ yoke element supports said handguard piece relative to said receiver.

The amendment to claim 29 is intended to clarify the term "yoke element" which was inconsistent in the original claim. The supporting function of the yoke element is still recited in the final wherein clause in the last line of the claim. In addition, the

applicant has corrected spelling of the term “rearward” which originally appeared in the claims as “reward”. No new matter or issue is believed to be involved.

Explanation of amendment to claim 30.

The amendments to claim 30 relative to the prior text are specifically identified below as a courtesy to the examiner:

a supporting element engaged with ~~to~~ said forward portion of said receiver, said supporting element extending forwardly from said forward portion of said receiver into said ~~reward~~ rearward end of said handguard piece, said supporting element being configured and arranged for engagement with said rearward end of said handguard piece,

wherein said supporting element ~~supporting~~ supports said handguard piece relative to said receiver.

The applicant has made several grammatical corrections to the claim including removal of the word “to”, and correction of the term “supports” which originally appeared in the claim as “supporting”. In addition, the applicant has corrected spelling of the term “rearward” which originally appeared in the claims as “reward”. No new matter or issue is believed to be involved.

Consideration and allowance of all claims is respectfully solicited.

**FORMAL REQUIREMENT FOR SURRENDER OF PATENT CERTIFICATE:**

The Application was indicated as being in condition for allowance except for surrender of the original patent certificate or a statement that the original patent is lost.

37 CFR 1.178 was changed in September 2004 to eliminate the requirement for the noted surrender or statement. PTO FORM SB 55 has been eliminated from the website and parties are directed to a Federal Register notice of final rule. The relevant change to section 1.178 is referenced below. Explanation of the rule change identifies that the rule change is retroactive and instructs the applicant that a proper response is to identify that the requirement is moot. In light of the change in rules, it is believed that the surrender or statement is no longer required.

**§ 1.178 Original patent; continuing duty of applicant.**

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

Relevant text from Federal Register Notice

**Section 1.178:** Section 1.178 is amended to eliminate the requirement for physical surrender of the original letters patent (*i.e.*, the “ribbon copy” of the original patent) in a reissue application, and to make surrender of the original patent automatic upon the grant of the reissue patent. The reissue statute provides in part that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the *surrender of such patent* and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. See 35 U.S.C. 251, ¶ 1 (emphasis added).

While 35 U.S.C. 251, ¶ 1, requires a “surrender” of the original patent, it neither requires a physical surrender of the actual letters patent, nor a statement that the patent owner surrenders the patent. Physical surrender by submission of the letters patent (*i.e.*, the copy of the original patent grant) was previously required by rule via § 1.178; however, such submission was only symbolic because the patent right exists independently of physical possession of the letters patent.

It is the right to the original patent that must be surrendered upon grant of the reissue patent, rather than any physical document. Thus, where the letters patent is not submitted during the prosecution of the reissue application because it is stated in the reissue that the letters patent copy of the patent is lost or inaccessible, there is no evidence that any stigma is attached to the reissue patent by the public. Further, there was no case law treating such a reissue patent adversely due to the failure to submit the letters patent. In fact, there is no legal reason to retain the requirement for physical surrender of the letters patent. Conversely, it is beneficial to eliminate the requirement for physical surrender of the letters patent.

It is beneficial to both the Office and the public to establish that the surrender of the original patent is automatic upon the grant of the reissue patent to thereby eliminate the requirement for a physical submission of the letters patent or the filing of a paper offering to physically surrender the letters patent (§ 1.178(a)).

Previously, the requirement for submission of the patent document compelled the patent owner (seeking reissue) to try to obtain the letters patent copy of the patent. If the document was lost or misplaced, the patent owner had to search for it. If it was in the hands of a former employee, the patentee had to make an effort to secure it from that employee (who might not be on friendly terms with the patentee). If the letters patent was obtained, it then had to be physically submitted without losing or destroying it. If the letters patent could not be obtained, the patent owner had to make a statement of loss (Form PTO/SB/55) or explain that it could not be obtained from the party having physical possession of it. The revision of § 1.178 eliminates these burdens, and the requirement for use of form PTO/SB/55 or its equivalent.

The requirement for submission of the letters patent copy of the patent previously provided an unnecessary drain on Office processing and storage resources in dealing with the submitted letters patent document. Further, in the event the reissue was not granted, the Office had to return the letters patent to the applicant where such was requested. The revision does away with the burden on the Office of processing, storing, and returning letters patent.

The previous requirement for submission of the original patent (the letters patent), or a statement as to its loss, resulted in a “built in” delay in the prosecution while the Office awaited submission of the letters patent or the statement of loss, which was often submitted only after an indication of allowance of claims. The revision reduces reissue application pendency because the Office no longer needs to delay prosecution while waiting for the letters patent or the statement of loss. Thus, the complete elimination of the requirement for an affirmative act (of surrender) by the patent owner puts reissue in

step with other post patent proceedings for changes of patents which have no requirement for a statement of surrender (e.g., reexamination certificate, certificate of correction).

Amended § 1.178 applies retroactively to all pending applications. For those applications with an outstanding requirement for the physical surrender of the original letters patent, applicant must timely reply that the requirement is moot in view of the implementation of the instant amended rule. Such a reply will be considered a complete reply to any requirement directed toward the surrender of the original letters patent. It is to be noted that the Office will not conduct a search to withdraw Office actions where the only outstanding requirement is compliance with the physical surrender of the original letters patent.

**FORMAL DRAWINGS:**

The original patent certificate was issued with drawings that included hand numbered reference characters. New Formal Drawings are enclosed for use in the Reissue Patent.

Accordingly, the present application is now believed to be in condition for allowance and ready for issue.

Corresponding action is respectfully solicited.

PTO is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our account #02-0900.

The Examiner is invited to telephone the undersigned should any questions arise.

Respectfully submitted,



Stephen J. Holmes  
Reg. No. 34621

BARLOW, JOSEPHS & HOLMES, Ltd.  
101 Dyer Street, 5<sup>th</sup> Floor  
Providence, RI 02903  
(401) 273-4446 (tel)  
(401) 273-4447 (fax)  
sjh@barjos.com